

REMARKS

In the present Amendment, Claims 1-15, 18 and 19 have canceled without prejudice or disclaimer. Upon entry of the Amendment, Claims 16 and 17 will be pending. Entry of this after-final Amendment is deemed to be proper because it simplifies issues for appeal.

(a) On page 2 of the Office Action, Claim 15 was objected to as being dependent on a canceled claim and as allegedly failing to further limit the silver compounds in Claims 1 and 2.

Without conceding to the merits of the rejection, Claim 15 has been canceled herein to advance prosecution.

Withdrawal of the objection is requested.

(b) On page 2 of the Office Action, Claims 1 and 2 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Without conceding to the merits of the rejection, Claims 1 and 2 have been canceled herein to advance prosecution.

Withdrawal of the Section 112 rejection is requested.

(c) In Paragraph No. 1 at page 4 of the Office Action, Claims 16-19 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Pub. No. 2003/0124259 (Kodas) in view of USPN 4,049,844 (Bolon). In Paragraph No. 2 at page 6 of the Office Action, Claims 1, 2, 4, 6, 7, 9-14 and 16-19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kodas.

Applicants respectfully traverse.

Claim 16 recites “consisting of” transitional language and, thus, excludes the use of metallic silver as a conducting component. Therefore, Kodas fails to anticipate or render obviousness the conductive composition recited by Claim 16. The Office Action states “[W]hen,

as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is anticipated if one of them is in the prior art.” (Office Action at p. 5.) However, the disclosure of Kodas at paragraphs 273-275 and 280 teaches a combination of metallic silver and a silver compound which are not in parallel relation or selective relation, and does not disclose a composition consisting of a specific silver compound and a binder.

The Office Action, regarding a combination of Ag precursors and binders, applies the teaching of Bolon. However, the portion of Bolon referred to by the Examiner only discloses the combination of the two components and does not disclose the proportion of the two components. Further, Bolon fails to provide one of ordinary skill in the art with any reason to exclude the other components of the composition taught by Kodas. Moreover, Bolon discloses a working Example which is a switch coating mixture prepared with 4.5 g silver carbonate, 0.5 g silver oxide, 0.1 g of an acetylene glycol type non-ionic surfactant, and 0.17 g ethyl hydroxyethyl cellulose binder. (Bolon at col. 8, lines 40-43.) This example includes a surfactant, which is a component other than silver compounds and a binder, and moreover, discloses 3.4 parts by weight of binder relative to 100 parts by weight of silver compounds (which is outside of the scope of present Claim 16).

The arguments above similarly apply to independent Claim 17.

In view of the above, reconsideration and withdrawal of the Section 102 and 103 rejections of the present claims are respectfully requested.

(d) On page 9 of the Office Action, Claims 1, 2, 4, 6, 7, 9-14 and 16-19 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over Claims 1, 4-6, 9-18 and 20-24 of copending Application No. 10/500,124 - as amended on November 25, 2008 - in view of Kodas.

Without conceding to the merits of the rejection, Applicants submit that the amendments to the claims and the arguments set forth above overcome the obviousness-type double patenting rejection of the present claims based on U.S. App. No. 10/500,124 in view of Kodas.

(e) Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local, Washington, D.C., telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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